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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,419	07/09/2003	Bajko Gabor	39700-580001US/NC39543US	7976
64046 7590 03/17/2010 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER HOANG, DANIEL L				
ART UNIT		PAPER NUMBER		
2436				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/615,419

Applicant(s)

GABOR ET AL.

Examiner

DANIEL L. HOANG

Art Unit

2436

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,12,26,28,29,31-33,35,37-39 and 42-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,12,26,28,29,31-33,35,37-39 and 42-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

RESPONSE TO ARGUMENTS

1. Applicant's arguments with respect to claims -2, 5-8, 12, 26, 28-29, 31-33, 35, and 37-39, 42-57 have been considered but are moot in view of the new ground(s) of rejection.

CLAIMS PRESENTED

Claims 1-2, 5-8, 12, 26, 28-29, 31-33, 35, and 37-39, 42-57 are presented.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 38 and intervening claims are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the

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method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion *Ex parte Langemyer et al.*

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation.

Thus, the claims are non-statutory.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Regarding claims 29 and 32, the word "means" is preceded by the word(s) "forwarding" and "receiving" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

5. **Claims 29 and 32 are also rejected for lacking the required corresponding structure.**

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-2, 5-8, 12, 26, 28-29, 31-33, 35, and 37-39, 42-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirttimaa (US PGP No. 20030154400), and further in view of Egevang, US Patent No. 7159109.

As per claim 1 and 26, 29, 31-32, 38, Pirttimaa teaches:

A method comprising:

forwarding a prefix value to a node in a packet switched environment to create a security association with the node based on the prefix value, said prefix value referring to a portion of a internet protocol address.

[see paragraph 40, 42] UE140 is interpreted as the first node, P-CSCF is interpreted as the second node, the SIP register message with address included is interpreted as the prefix value being forwarded.

The Pirttimaa reference has been discussed above. While Pirttimaa teaches a method of setting up a security association, Pirttimaa is mute in teaching that the security association is valid for a plurality of different internet protocol addresses, each of said plurality of internet protocol addresses comprising said portion of the first internet protocol address to which the prefix value refers.

For this limitation, examiner relies on the Egevang reference. Egevang teaches a method for managing address translation for secure connections. See col. 8, lines 22-67 and col. 9, lines 1-29, wherein Egevang teaches first setting up a security association for communication between network node 102 and LAN 108 which includes network node 110 and 112. The security association is set up for both inbound and outbound traffic. Once the security association is set up for LAN 108, both nodes 110 and 112 may use the same security association without the need to set up separate security associations. Examiner views this to be analogous to the limitation claimed by applicant above. It would have been obvious to one of ordinary skill in the art to modify the invention taught by Pirttimaa to include setting up a security association that is valid for multiple IP addresses, as taught by Egevang, in order to improve management of a Security Association by improving the overall capacity and performance of the network (Egevang, col. 2, lines 3-30).

As per claim 2 and 42, 52, Pirttimaa teaches:

A method as claimed in claim 1, wherein the packet switched environment is a IP Multimedia Subsystem (IMS) of a 3rd generation (3G) network.

[see paragraph 2]

As per claim 3 and 43, Pirttimaa teaches:

A method as claimed in claim 1, wherein the first node is User Equipment (UE).

[see rejection of claim 1]

As per claim 53, Pirttimaa teaches:

A method as claimed in claim 1, wherein the second node is a Proxy Call State Control Function (P-CSCF)

[see rejection of claim 1, "P-CSCF"]

As per claim 5 and 45, Pirttimaa teaches:

A method as claimed in claim 1, wherein the message is a protocol message.

[see rejection of claim 1, "SIP Register"]

As per claim 6 and 46, Pirttimaa teaches:

A method as claimed in claim 5, wherein the protocol is a Session Initiation Protocol (SIP).

[see rejection of claim 5]

As per claim 7 and 47, 55, Pirttimaa teaches:

A method as claimed in claim 1, wherein the message is a SIP REGISTER message.

[see paragraph 40]

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As per claim 8 and 48, 56, Pirttimaa teaches:

A method as claimed in claim 1, wherein the prefix value is included in a header of the message.

[see rejection of claim 1 wherein the SIP register message includes the address in the header.]

As per claim 12, Pirttimaa teaches:

The method as claimed in claim 1, wherein the prefix value is allocated by a gateway general packet radio service support node.

[see paragraph 42, wherein the prefix is derived from a received IP datagram conveying the SIP message]

As per claim 49 and 57, Pirttimaa teaches:

A method as claimed in claim 8, wherein the header is a Security-Client header.

[see paragraph 42]

As per claim 50, Pirttimaa teaches:

A method as claimed in claim 9, wherein the prefix value is included in an extension parameter of the Security-Client header.

[see rejection of claim 8]

As per claim 51, Pirttimaa teaches:

A method as claimed in claim 1, wherein the prefix value is allocated by a Gateway GPRS Support Node (GGSN).

[see paragraph 4]

As per claim 28 and 44 and 54, Pirttimaa teaches:

A method as claimed in claim 1, wherein the forwarding of the prefix value from the first node to the second node comprises forward the prefix value in a message.

[see rejection of claim 1 wherein the prefix value is sent in a SIP request message]

As per claim 33, 35, 37, and 39, Pirttimaa teaches:

The method as claimed in claim 1, wherein the first internet protocol address and another of the plurality of internet protocol addresses, are internet protocol addresses of the same apparatus.

[see paragraph 43]

POINTS OF CONTACT

- *. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulaney Street
Alexandria, VA 22314

- *. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Hoang whose telephone number is 571-270-1019. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Daniel L. Hoang/

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/Eleni A Shiferaw/

Primary Examiner, Art Unit 2436